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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,748	01/29/2001	Hisashi Narimatsu	1241.17	4282

7590 07/19/2002  
Fitzpatrick Cella Harper & Scinto  
30 Rockefeller Plaza  
New York, NY 10112-3801

EXAMINER

RAO, MANJUNATH N

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/744,748

Applicant(s)

NARIMATSU ET AL.

Examiner

Manjunath N Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-75 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18, 24, 51-53, drawn to Polypeptide, polynucleotide, vectors, host cells and a method of making the polypeptide and a method of using the polypeptide.

Group II, claim(s) 19-20, 54, 55, drawn to a method of producing a reaction product wherein fucose is added to glucose.

Group III, claim(s) 21 and 56, drawn to a method of producing a reaction product wherein fucose is added to glucose or N-acetylglucosamine by culturing a transformant.

Group IV, claim(s) 22, 25, 57, drawn to a method of producing a reaction product by feeding non-human transgenic animal such that the reaction product is produced in the milk.

Group V, claim(s) 23, 58, drawn to a method of producing a reaction product by growing a transgenic plant such that the reaction product is produced by the plant.

Group VI, claim(s) 26, drawn to a method of determining the expression level of the gene encoding  $\alpha$ -1,3 fucosyltransferase by hybridization.

Group VII, claim(s) 27-28, drawn to an oligonucleotide and its derivative.

Group VIII, claim(s) 30, drawn to a method for detecting encephalopathy.

Group IX, claim(s) 31, drawn to a method for suppressing transcription of the DNA using polynucleotides with SEQ ID NO:3, 4, or 5.

Group X, claim(s) 33, 60 drawn to a method for suppressing transcription of the DNA using oligonucleotides and its derivatives.

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Group XI, claim(s) 32, drawn to a method of suppressing the translation of the RNA using SEQ ID NO:3, 4, or 5.

Group XII, claim(s) 34, 61 drawn to a method of suppression of translation of RNA using the oligonucleotides.

Group XIII, claim(s) 35, 38-39, drawn to an antibody.

Group XIV, claim(s) 36-37, drawn to an immunoassay to detect the polypeptide.

Group XV, claim(s) 40, drawn to a method for screening a substance which modulates the activity of the polypeptide.

Group XVI, claim(s) 41-42, drawn to a method for screening a substance which modulates the expression of the polypeptide.

Group XVII, claim(s) 43-45, 62, drawn to a promoter DNA for transcription of the polypeptide.

Group XVIII, claim(s) 46-47, 63-68, drawn to a method of screening a substance that changes the efficiency of transcription by the promoter.

Group XIX, claim(s) 48-49, drawn to a non-human knock-out animal.

Group XX, claim(s) 50, drawn to a method for treating renal diseases or cancer by suppressing transcription of the DNA.

Group XXI, claim(s) 29, 59, drawn to a method for determining level of expression by PCR.

Group XXII, claim(s) 69, drawn to a method of treating renal disease by suppression of translation using the SEQ ID NO:3, 4, or 5.

Group XXIII, claim(s) 70-71, drawn to a method of treating renal disease or cancer by suppressing transcription using oligonucleotides.

Group XXIV, claim(s) 72-73, drawn to a method of treating renal disease or cancer by suppressing translation using oligonucleotides and their derivatives.

Group XXV, claim(s) 74-75, drawn to a method for detecting renal diseases and cancer using PCR.

The inventions listed as Groups I-XXV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special

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technical features for the following reasons: An initial search of the prior art indicates that the invention of claim 1, (group I) was already known in the prior art and thus when the invention is considered as a whole does not contribute over the prior art. See Weston et al., 1992, JBC Vol 267(6):4152-4160 or Takashi Kudo et al., 1998, JBC, Vol. 273(41):26729-26738.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N Rao whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.

Manjunath N. Rao  
July 16, 2002

*Rebecca Prouty*  
**REBECCA E. PROUTY**  
**PRIMARY EXAMINER**  
• **GROUP 1800**  
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